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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/723,276

11/25/2003

Constantin Donea

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EXAMINER

LONEY, DONALD J

ART UNIT

PAPER NUMBER

1772

MAIL DATE

DELIVERY MODE

07/25/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/723,276	Applicant(s) DONEA ET AL.	
	Examiner Donald Loney	Art Unit 1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6 and 9-28 is/are pending in the application.
- 4a) Of the above claim(s) 13-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,5,6 and 9-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1, 5, 6 and 9-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 2 the term "consisting of" is recited. In lines 11 and 12 optional elements are recited. This is inconsistent with the "consisting of" language since this language excludes all other elements from the claim. Consisting of is limited to only those things positively recited in the claims, therefore, optional elements cannot be included. Additionally, line 11 recites one or more layers which is inconsistent with the "consisting of" language since it unclear as to how may additional layers can be present. Also, claims 5 and 6 add a polyester, which is an additional component, excluded by the "consisting of" language. Claim 11 also adds additional component excluded by the "consisting of" language. See MPEP section 2111.03. In claim 1, line 14 the term and/or is indefinite since one cannot determine if all of the elements recited in this list include the carbon black or only one of them contains the carbon black. This and/or language would seem to indicate that only one of the elements recited can contain carbon black when from the original claim at least the first sheet, second sheet and ribs all contain carbon black.

Claim Rejections - 35 USC § 103

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3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1, 5, 6 and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Erb (4114597) in view of Schmitz et al (5360658).

Erb discloses a polycarbonate multiwalled sheet comprising ribs connecting a first and second sheet. Refer to figure 5 and 8 in Erb showing sheets 70 and 72

connected with ribs 84 and sheets 166 and 168 connected with ribs 172 respectively. Erb discloses the addition of carbon black to the polymer. See column 6, lines 51-55 in Erb. Since this is the same material disclosed for the electrically conductive filler of instant claim 1, the examiner deems the filler (i.e. electrically conductive) to be inherently the same as the recited invention since they are the same materials. With regards to the specific material in claim 1, see column 6, lines 51-55 and column 12, lines 14-44 in Erb does fail to specifically disclose the amount of carbon black as 6-22 weight percent. Erb is silent as thereto.

Schmitz et al discloses to include 13-18% by weight carbon black (one of applicants' fillers in claim 7) in a polymer resin in order to provide conductivity thereto. Refer to the Abstract along with column 1, lines 13-22, 40-42 and column 2, lines 58-65. Additionally Schmitz et al discloses it is known to include 10-25% carbon black in polymers of the prior art at column 1, lines 43-46.

Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to Erb to include carbon black (or any other conductive filler) in the resin, as taught by Schmitz et al, in order to impart conductivity thereto motivated by the fact Erb teaches that fillers can be included in the resin. The properties of claims 9 and 10 would be obvious to one of ordinary skill in the art motivated by the fact one would include the required amount of conductive filler to impart said properties in order to conform the product to its desired application. The additives per claim 11 would be obvious as a known means to provide a particular function thereto. With regards to the "consisting of" language in claim 1, the examiner deems that the

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additional ribs shown in Erb are not excluded therefrom since the applicant themselves recite additional ribs in lines 11 and 12 in claim 1. The examiner is best attempting to include an art rejection over the claims even though there is the 35 USC 112 issue as discussed above which makes it difficult to understand the scope of the claims.

Response to Arguments

7. Applicant's arguments with respect to claims 1, 5, 6 and 9-12 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

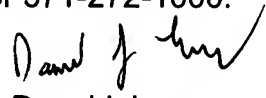
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571 272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Donald Loney
Primary Examiner
Art Unit 1772

DJL:D.Loney
07/21/07